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In re Application of
WAKABAYASHI, Hidehiko, et al.
Application No.: 09/926,180
PCT No.: PCT/JP00/02179
Int. Filing Date: 04 April 2000
Priority Date: 20 April 1999
Attorney's Docket No.: 213233US0PCT
For: FLAVOR PRECURSOR COMPOSITION
AND METHOD FOR RELEASING THE
FLAVOR COMPONENT

DECISION ON

PAPERS

UNDER 37 C.F.R. 1.42

This decision is in response to applicants' filing of a declaration executed on behalf of deceased inventor Kyousuke Ishiguro by heirs of the estate on 10 October 2001. Applicants' submission is taken as an indication that joint inventor Kyousuke Ishiguro is deceased and is being treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 04 April 2000, applicants filed international application PCT/JP00/02179, which claimed a priority date of 20 April 1999 and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 26 October 2000.

A Demand electing the United States was filed with the International Preliminary Examining Authority on 13 October 2000. The election was made prior to the expiration of the nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 22 October 2001 (20 October 2001 was a Saturday).

On 19 September 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, the fee for filing the declaration later than 30 months and an English translation of the international application.

On 10 October 2001, applicants submitted a declaration signed by three of the inventors and by four heirs of deceased inventor Kyousuke Ishiguro.

On 24 October 2001, prior to the matching of the 10 October 2001 submission with the application file, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors was required. This Notification set a two month extendable period for reply.

On 05 November 2001, applicants filed, "Response to Notification of Missing Requirements," stating that applicants had filed a declaration on 10 October 2001, supplying a copy of the postcard receipt and a copy of the declaration as filed.

DISCUSSION

A declaration for an international application must comply with 37 CFR 1.497(a)-(b), which requires in part that the oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43 or 1.47. First, Second and Fourth joint inventors, Hidehiko Wakabayashi, Hirokazu Kawaguchi and Yoichi Ueda, respectively, signed the declaration providing their residences, citizenships and postal addresses. However, the information of Kyousuke Ishiguro is unsigned and followed by the information and signatures of four joint heirs of Kyousuke Ishiguro.

Under 37 CFR 1.42, in case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. All of the heirs may make application for a patent on behalf of a deceased inventor as legal representative of the estate, provided a legal representative has not been appointed nor is one required to be appointed by applicable law. MPEP 409.01(d).

The declaration submitted on 10 October 2001 is not in compliance with 37 CFR 1.42, because though indicating that Minori Ishiguro, Tatsuya Ishiguro, Shouji Ishiguro and Youei Ishiguro are joint heirs, it does not indicate that they are all of the heirs of Kyousuke Ishiguro or that they are collectively the legal representative of the estate. That is, by merely indicating that the four heirs are joint heirs, it leaves open the possibility that there may be other heirs whose signatures would also be required on the declaration for the heirs to constitute the legal representative of the estate.

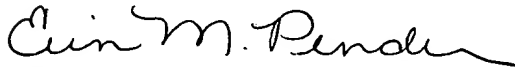
If the persons signing on behalf of the deceased inventor are all of the heirs or are the legal representative of the estate, this may be stated in the declaration. Alternatively, a statement may be filed either by the persons signing on behalf of the deceased inventor or by the applicants' attorney certifying that these persons are all of the heirs or that the signers are collectively the legal representative of the deceased inventor.

CONCLUSION

For the above reasons, the request for status under 37 C.F.R. 1.42 is **REFUSED**.

Applicants are required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 1.42."

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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